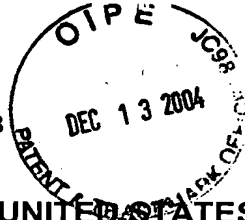


Docket No. 3350-051
File No. 1158.41315CC8
Client No. Ebill-I



PATENT

IFWAF
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

KITCHEN, et al.

Serial No. 09/892,628

Filed: June 28, 2001

For: ELECTRONIC BILL PRESENTMENT INTERFACE

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: Group Art Unit: 3622

: Examiner: R. Alvarez

TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 13, 2004

Sir:

Transmitted herewith is an Appeal Brief in the above-identified application.

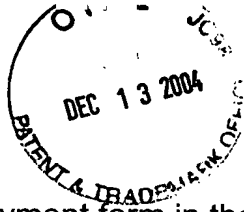
☐ No additional fee is required.

☐ Also attached:

The fee (if applicable) has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims			0	x \$18 =	\$0
Independent Claims			0	x \$86 =	\$0
		Appeal Brief			500.00
		TOTAL FEE DUE			\$500.00

Docket No. 3350-05I
File No. 1158.41315CC8
Client No. Ebill-I



PATENT

[X] A Credit Card Payment form in the amount of \$500.00 is attached

[X] Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 01-2135, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully Submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read "Sterling W. Chandler", with a long horizontal flourish extending to the right.

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SWC



Docket No.: 3350-05I
File No: 1158.41315CC8
Client Ref: EBILL-I



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of :
KITCHEN, et al. :
: Group Art Unit:3622
Application No: :
09/892,628 : Examiner: R. Alvarez
: :
Filed: :
June 28, 2001 :

For: ELECTRONIC BILL PRESENTMENT INTERFACE

APPEAL BRIEF

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed October 12, 2004 of the finally rejected claims as set forth in the Official Action dated July 9, 2004.

I. REAL PARTY IN INTEREST

CheckFree Corporation, Reel 9284, Frame 0159.

II. RELATED APPEALS AND INTERFERENCES

United States Patent Application Serial Numbers 09/867,587 and 10/060,745, which share a common parentage with the present application, are currently under appeal. An Appeal Brief was filed on May 3, 2004 in the Appeal of the 09/867,587 application, which subsequently has been allowed. An Appeal Brief was filed on July 26, 2004 in the Appeal of the 10/060,745 application.

III. STATUS OF CLAIMS

Claims 1-35, originally pending in a parent application, were cancelled by a preliminary amendment filed concurrently with this application. Claims 34-63 are pending in this application, of which claims 34, 46, and 56 are independent. Each of claims 34-63 is subject to appeal.

IV. STATUS OF AMENDMENTS

A Preliminary Amendment was filed on June 28, 2001 and has been entered. No after-final amendment has been filed in this application.

V. SUMMARY OF INVENTION

The invention will be summarized with reference to the preferred embodiment(s)/implementations(s) shown in Figures 2B, 9C 12A-12C, and 15, and described in the related specification on pages 14-17, 29, 32, 33, 35, and 36.

In preferred embodiments of the invention of independent claims 34 and 56, a process and a single screen display for electronically presenting bills are provided.

In a preferred embodiment of the invention of independent claim 46, a system for electronically presenting bills authorizing payment is provided. As shown in Figure 2B and as discussed on page 14, line 23, through page 15, line 31, page 16, line 26, though page 17, line 24, the system includes at least a display (detail 460), an input device (detail 465), and a processor (detail 450).

According to the recited process, as shown in Figure 15 and described on, for example, pages 35 and 36, a bill of a biller (detail 1505) is displayed in a first portion (detail 1505) of a single screen (1500). The displayed bill includes at least one of, as shown in detail 1520, a total amount due and a minimum amount due. Also included in the displayed bill is a payment due date (detail 1525). The process of claim 34 also requires display of, in a second portion (detail 1530) of the single screen (detail 1500), bill payment information (detail 1535). The bill payment information includes a payment data area for displaying a payment date (labeled "payment due date" in detail 1535), and a payment amount area for displaying a payment amount (labeled "total payment amount" in detail 1535).

According to the recited system, the display (detail 460) is configured to present a bill of a biller (detail 1505) in a first portion (detail 1505) of a single screen (detail 1500), and bill payment information (detail 1535) in a second portion (detail 1530) of the single screen (detail 1500). The bill of the biller include at least one of a total amount due and a minimum amount due (detail 1520), as well as a payment due date (detail 1525). The bill payment information includes a payment data area for displaying a payment data, a payment amount area for displaying a payment amount, and a payment authorization indicator (detail 1545), for authorizing payment

of the displayed payment amount on the displayed payment date.

Also according to the recited system, the input device (detail 465) is for activating the payment authorization indicator (detail 1545), and the processor (detail 450) is for generating a message to authorize payment of the displayed payment amount on the displayed payment date based on the activation of the payment authorization indicator (detail 1545).

According to independent claim 46, the recited single screen display includes a bill of a biller (detail 1505) that includes, similar to independent claims 34 and 46, a payment due date and at least one of a total amount due and a minimum amount due. The single screen display also includes bill payment information (detail 1535) that includes a payment data area and a payment amount area for displaying a payment amount. The payment date automatically pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner (see, for example, page 32, lines 20-27).

Dependent claims 35 and 47 require, inter alia, automatically initially displaying in the payment data area as the payment date, a payment date that pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner. Dependent claims 36 and 48, require, inter alia, first and second modes of payment with corresponding first and second predating amounts of time. Dependent claims 37 and 49 require, inter alia, that a first payment mode be by hardcopy check, and a second payment mode be by electronic fund transfer (see, for example, page 32, lines 20-31).

Dependent claims 38, 50, and 57 require, inter alia, an area for specifying a

payment period for a one or more future payments (see, for example, detail 1225 of Figure 12, and page 32, line 31, through page 33, line 1).

Dependent claims 39 and 51 require, inter alia, a payment status indicator for indicating a status of payment of a displayed payment amount (see, for example, detail 985 of Figure 9C, and page 29, lines 16-19).

Dependent claims 40 and 52 require, inter alia, display in the form of a check, and a cancelled check stamp displayed as a payment made indicator (see, for example, page 32, lines 14-18, page 35, lines 24-29), page 36, lines 10-40, and Figures 12A-C, and 15 (detail 1535).

Dependent claims 41 and 53 require, inter alia, a user command to change the displayed payment date to a modified payment date, and automatically changing the displayed payment date to the modified payment date (see, for example, page 32, lines 30 and 31, and page 35, lines 29-31).

Dependent claims 42, and 54 require, inter alia, user identification of a biller, and display of the identified biller as the payee name in the payee area (see, for example, page 30, lines 7-10, and page 32, lines 18-20). Dependent claims 43, and 61 require, inter alia, a selectable biller list including a plurality of billers (see, for example, Figure 12B, detail 1260).

Dependent claims 44 and 62 require, inter alia, displaying at least one of a first indicator corresponding to terms and conditions associated with the displayed bill (detail 1555), a second indicator corresponding to advertisements (detail 1560), and a third indicator corresponding to customer care (detail 1565).

Dependent claims 45, 55, and 63 require, inter alia, that bill payment

information be displayed in a check format (see, for example, Figures 12A-C, Figure 15, detail 1535, page 32, lines 14-18, and page 35, lines 24-29).

Dependent claim 58 requires, inter alia, a payment made indicator for indicating that the displayed payment amount has been paid (see, for example, Figure 15, detail 1570, and page 36, lines 10-14).

Dependent claim 60 requires the bill payment information to include a payee area for displaying a payee name (see, for example, Figure 15, detail 1535, label "Pay to XYZ Company").

VI. ISSUES

Whether claims 34-45 and 56-63 are directed to non-statutory subject matter under 35 U.S.C. § 101.

Whether claims 34, 38, 41-43, 46, 50-51, and 53-54 are anticipated under 35 U.S.C. § 102(b) by Hogan (U.S. Patent No. 5,699,528).

Whether claims 35-37, 39-40, 44-45, 47-49, 52, and 55-63 are obvious, under 35 U.S.C. § 103(a), over Hogan.

VII. BRIEF DESCRIPTION OF THE REFERENCE

Hogan discloses an electronic bill presentment service in which an electronic bill service company (EBSC) electronically presents a bill on behalf of a payee (biller) to a subscriber of the service (payor) (see column 4, line 53, through column 5, line 6). As described in column 5, lines 43, each subscriber registers (enrolls) with the EBSC to begin to receive electronic bills.

Hogan discloses two embodiments for actual electronic presentment. In both embodiments, a bill image is received from a biller and formatted for presentation to a customer (also called a subscriber or payor) (see, for example, column 4, lines 53-67, column 5, lines 53-57, and column 9, lines 50-53). Hogan teaches that a bill image received from a biller is formatted by the bill service for presentment as soon as that bill image is received (see column 5, lines 53-57, and column 9, lines 50-54).

In the first embodiment, formatted billing information is stored for eventual access by a subscriber. In other words, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35, and Figure 4). In the second embodiment, the formatted billing information is transmitted to a subscriber as an e-mail message by the bill service upon completion of the formatting (see, for example, column 2, lines 48-50; and Figure 11).

VIII. THE REJECTION

Claims 34-45 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 34, 38, 41-43, 46, 50-51, and 53-54 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hogan (U.S. Patent No. 5,699,528). Claims 35-37, 39-40, 44-45, 47-49, 52, and 55-63 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Hogan.

IX. ARGUMENT

Claims 34-45 stand finally rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 34, 38, 41-43, 46, 50-51, and 53-54 stand finally

rejected under 35 U.S.C. § 102(b) as anticipated by Hogan. Claims 35-37, 39-40, 44-45, 47-49, 52, and 55-63 stand finally rejected under 35 U.S.C. §103(a) as obvious over Hogan. Appellants respectfully traverse the rejections against the claims now pending on appeal.

As discussed below in detail, it is respectfully submitted that the Examiner has not met the burden of proof in establishing that the appealed claims are anticipated, has not met the burden of proof in establishing that the appealed claims are obvious, has not met the burden of proof in establishing that the appealed claims are non-statutory, has failed to provide the required factual basis and reasonable rationale for the prior art rejections, has failed to apply art which teaches or suggests the invention as claimed, and has failed to properly construe the applied art.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE UNDER EITHER 35 U.S.C. §102(b) OR 35 U.S.C. §103(a) FOR THE REJECTIONS OF CLAIMS 34-63

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitation, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the

patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

The Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). That is, objective evidence must be presented by the Examiner in support of the rejection. Without such support, the rejection is improper per se.

It is respectfully submitted that the Examiner has failed to establish a prima facie case for the prior art rejections. More particularly, the Examiner has failed to provide objective support or reasonable rationale for the rejections, has ignored limitations recited in the claims, and has applied art in a manner inconsistent with its teachings.

Independent claims 34, 46, and 56 each require, inter alia, displaying, in a first portion of a single screen, a bill of a biller including a payment due date and at least one of a total amount due and a minimum amount due, and displaying, in a second portion of the single screen, bill payment information including a payment date area for displaying a payment date, and a payment amount area for displaying a payment amount.

Throughout prosecution of the instant application the Examiner has pointed to Figure 4 as teaching the requirements of independent claims 34, 46, and 56. Figure 4, which represents a Web presentation in accordance with the World Wide Web

embodiment of Hogan, shows a bill of a biller electronically presented. The presented information includes a total amount due and information associated with a payment. However, Figure 4 clearly does not show, and the associated text at column 6, lines 25-64, in no way discloses, a payment due date, as required by the independent claims.

Furthermore, Figure 4 does not show a payment date. Rather, Figure 4, in detail 407, shows a user input area for either directing a payment on whatever date the user happens to be viewing the presentation of Figure 4 (shown as 'today'), or accessing a second presentation, different than that of Figure 4, to enter a specific payment date other than the instant date of viewing. The accessing of the second presentation to enter a specific payment date is described at column 6, lines 41-45. Thus, while a payment date might be displayed via a second presentation in Hogan, a payment date is not displayed in the presentation of Figure 4.

Also lacking in Figure 4 is a payment amount. Rather, Figure 4, in detail 411, shows a user input area for either directing a payment in the full bill amount, or directing a payment in an amount less than the full bill amount. Thus, the only displayed amount in Figure 4 is a billed amount, not a payment amount. Further, if a user wishes to enter a particular payment amount other than a full bill amount, the user must select either the 'allowed partial' detail or other 'grievance' detail. After doing so, as described in column 6, line 59, through column 7, line 5, a second presentation is displayed to the user so that the user can enter the particular payment amount. Thus, while a payment amount might be displayed via a second presentation, a payment amount is not displayed in the presentation of Figure 4.

In the final Official Action, dated July 9, 2004, the Examiner responds to the above arguments by citing Dewey & Almay Chem. Co. v. Mimex Co., 124 Fed. 2 986, 52 USPQ 138 (Second Cir. 1942) in support of the anticipation rejection. However, rather than supporting the Examiner's conclusions, Judge Hand's opinion in Dewey further supports applicants' traversal. As noted by Judge Hand, "no doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bare within its four corners adequate directions for the practice of the patent invalidated .. if it does not inform the art without more how to practice the invention, it has not correspondingly enriched the store of common knowledge and it is not an anticipation." In finding the patent at issue valid, Judge Hand goes on to state that "these inventors did not move along a well-marked way; they stuck out a new path which led to a goal ... To say that for this they needed to look no further a field than the ordinary routineer, one must shut one's eyes to all the significant facts". It is respectfully submitted that the Hogan reference fails to meet the test of anticipation as set forth by Judge Hand in 1942 and by other Justices in subsequent cases before both the CCPA and the CAFC.

Also in the July 9, 2004 final Official Action, the Examiner seems to argue, as can best be understood, that a payment date is displayed in Hogan's Figure 11, as well Figure 4. As will be understood from the above, Figure 4 does not teach or suggest display of a payment due date. It is acknowledged that the embodiment depicted by Hogan in Figure 11 includes a payment due date area (detail 1105), however it lacks the required second portion of the single screen display, as appears to be acknowledged by the Examiner in the final action. Thus, the Figure 11

embodiment also fails to teach or suggest that recited in the independent claims.

In the final Official Action the Examiner again asserts that Figure 4 teaches the required payment amount area for displaying the payment amount in a second portion of the single screen display. However, no reasonable rationale is provided to support the Examiner's conclusion. Each independent claim requires that the amount due must be displayed in a first portion of the single screen display, whereas the payment amount must be displayed in a payment amount area in a second portion of the single screen. Hence, the displayed amount due and the displayed payment amount must necessarily be displayed as different images in different portion of the same screen. Thus, the Examiner's contention that the "total amount now due" shown in Figure 4 corresponds to a displayed payment amount is logically flawed. Furthermore, and as discussed above, to the extent Hogan provides a payment amount area for displaying a payment amount, it is on a separate screen from that shown in Figure 4.

In the advisory action, dated September 9, 2004, the Examiner again asserts that Figure 4 of Hogan teaches the required payment amount area. As can best be understood, the Examiner has ignored previously made arguments that the displayed amount due and the displayed payment amount must necessarily be displayed as different images. The Examiner's rationale cannot be understood. What breaking an amount due into partial payments has to do with displaying, in separate portions of a single screen display, a payment amount and an amount due is simply not understood.

Regarding claims 38, 50, and 57, the Examiner, in the first Official Action,

relied upon detail 411 of Hogan's Figure 4 as teaching bill payment information including a periodic payment area for directing future payments. It is respectfully submitted that no part of Figure 4 teaches or suggests periodic, i.e., recurring, payments. In paragraph 10 of the July 9, 2004 final Official Action the Examiner notes that column 6, lines 59-64, of Hogan discloses an "allowed Partial" option for making partial payments, and contends that this teaches a periodic payment area as required by claims 38, 50, and 57. No reasonable rationale was provided in support of this contention.

Contrary to the Examiner's position, it is first to be noted that the periodic payment area required in claims 38, 50, and 57 must be part of the bill payment information which is displayed in the second portion of the single screen. Furthermore, in column 6, lines 59-64, what Hogan is discussing is a partial payment, not a periodic payment. Nowhere does Hogan suggest that an area be provided for displaying a periodicity at which further payments of a displayed payment amount are to be made after the displayed payment date, and the Examiner has failed to identify any support within Hogan for a contrary conclusion.

Regarding claims 43, 54, and 61, the Examiner, in the first Official Action, relied upon Figures 10 and 11 as teaching display of a plurality of biller identifiers, or a selectable biller list including a plurality of billers. Figures 10 and 11 are associated with the e-mail embodiment of Hogan. With reference to column 10, line 52, through column 11, line 37, Hogan discloses that a list of unpaid and/or, unviewed e-mail billing items is presented to a user via a first display screen, shown in Figure 10. Each billing item of Figure 10 includes a biller's name, bill amount, and

due date. In response to a user selection of one of the billing items of Figure 10, a second, different, display screen is then presented to the user, shown in Figure 11. Thus, Hogan does not teach or suggest the required first portion and second portion of single screen. Rather, Hogan discloses two screens (Figures 10 and 11) for displaying the same information required to be displayed in the single screen of claims 43, 54, and 61.

Paragraph 12 of the final Official Action presumably, as can best be understood, addresses the above traversal arguments, contending that in Figure 11 of Hogan discloses a selectable biller list on the single screen. As pointed out above, Figure 11 depicts an e-mail bill presentation, and accordingly has no need for, and indeed lacks any, selectable biller list. Accordingly, on this basis alone, the rejection cannot be understood. Even if Figure 11 did include a selectable biller list, the embodiment of Figure 11 lacks numerous other requirements of each of the independent claims. In the Advisory Action, the Examiner argues, "Hogan teaches a selectable biller list (Electric Co.) a list can consist of one item." While one could argue that a list can consist of one item, the instant claims require more than that. Claims 43 and 61 each require, and explicitly recite, "a selectable biller list including a plurality of billers", and claim 54 requires, and explicitly recites, display of "a plurality of biller identifiers on the single screen. According to the Examiner's own position, Figure 11 discloses a "list" of one item, and thus cannot teach or suggest that recited in claims 43, 54, and 61.

Regarding claims 41 and 53, in the first Official Action the Examiner argued that detail 407 of Figure 4 of Hogan teaches changing a displayed payment date to a

modified payment date and displaying the modified payment date in the bill payment information portion of the single display. Hogan does not display a payment date. Rather Hogan merely displays an indication to direct a payment on the date a bill is being viewed. Hogan discloses an entirely different screen for entering a particular payment date other than the instant date that a bill is being viewed. The Examiner has yet to respond to these previously submitted traversal arguments. Thus, the Examiner has implicitly acknowledged an inability to rebut the traversal of rejections relating to claims 41 and 53.

Regarding claims 35-37 and 47-49, in the first Official Action the Examiner acknowledged that Hogan fails to teach or suggest, but took Official Notice of, a payment date that pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner being automatically displayed initially in the payment date area as the payment date.

Regarding claims 39 and 51, the Examiner acknowledged that Hogan fails to teach or suggest the recited "payment status indicator," and took Official Notice thereof.

Regarding the requirement of claims 40, 45, 52, 55, 59, and 63 that payment information be displayed in the form of a check, the Examiner argued in the first Official Action, as could be best understood, that while Hogan does not disclose display in the form of a check, it would have been obvious to modify Hogan thusly. No art was cited in support of this contention. It was requested, in traversing the first Official Action rejections, that the Examiner cite and properly apply art which discloses display of payment information in the form of check in support of the

Examiner's position.

Regarding claims 44 and 62, the Examiner, in the first Official Action, relied upon Official Notice that it is old and well known "in bill payments to send advertisements with bills to induce the customers to make purchases" and that it would have been obvious to include such.

Regarding claim 58, the Examiner, in the first Official action, relied upon Official Notice that it is old and well known to include a 'payment made' indicator and that it would have been obvious to include such.

In responding to the first Official Action it was requested that the Examiner provide support for the Official Notice taken in each of claims 35-37, 39-40, 44-45, 47-49, 51-52, 58-59, and 62-63. In the final Official Action the Examiner failed to supply the requested support, instead arguing "since Applicant didn't command a response or request of such personal knowledge such as to provide a proper challenge that would hat least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where In re Boon is mentioned." In the Request for Reconsideration filed September 9, 2004, it was pointed out that the Examiner's failure to provide the requested support was an implicit acknowledgement of an inability to rebut the traversal of rejections relating to these claims.

In the Advisory Action, the Examiner responds: "With respect to the official notice, since the applicant has not provided a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the official notice is sustained." The Examiner's position is not understood.

According to MPEP 2144.03(C), if an Official Notice is challenged as not

properly based upon common knowledge, the Examiner must support the finding with adequate evidence. Not only were such challenges made in the first traversal (see, for example, pages 9-11 of the April 12, 2004 Request for Reconsideration), but it was requested that the Examiner cite and properly apply that for which Official Notice was taken. Additionally, MPEP 2144.03 makes no reference to an In re Boon.

In view of the above, it is respectfully submitted that the Examiner has failed to establish a prima facie basis for the prior art rejections of the pending claims.

2. THE APPLIED REFERENCE FAILS TO TEACH OR SUGGEST THE CLAIMED INVENTION

35 U.S.C. §102 Rejection of Claims 34, 38, 41-43, 46, 50-51, and 53-54, And 35 U.S.C. §103 Rejection Of Claims 5-37, 39-40, 44-45, 47-49, 52, and 55-63

Anticipation, under 35 U.S.C. §102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. Although anticipation requires only that the claim under attack “read on” something disclosed in the reference, all limitations of the claim must be found in the reference, or “fully met” by it. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re

Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In rejecting claims under 35 U.S.C. 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). It also is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 86 S. Ct. 684, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3d 1531, 28

USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987). It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 208 USPQ 817 (CCPA

1981). Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, supra. Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sense.

The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975).

Again, the issue is not whether it is within the skill of the artisan to make the proposed modification but, rather, whether a person of ordinary skill in the art, upon consideration of the references, would have found it obvious to do so. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), In re Keller,

supra. and In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (CAFC 1989).

As discussed above in detail, the applied prior art fails to teach or suggest the limitations any of the independent claims. In particular, Hogan does not teach or suggest a process for electronically presenting bills, a system for electronically presenting bills authorizing payment, or a single screen display for electronically presenting bills, in which bill of a biller including a payment due date and at least one of a total amount due and a minimum amount due is displayed in a first portion of a single screen, and in which bill payment information including a payment date area for displaying a payment date, and a payment amount area for displaying a payment amount is displayed in a second portion of the single screen.

As will be understood from the discussion above, Hogan merely discloses, in Figure 4, a bill of a biller electronically presented including a total amount due, but not a payment due date, a payment date, or a payment amount.

Also, as will be understood from the discussion above, Hogan fails to teach or suggest the requirements of various ones of the dependent claims.

In view of the above, it is respectfully submitted that Hogan fails to teach or suggest the invention as recited in the pending claims.

3. THE EXAMINER HAS NOT REASONABLY CONSIDERED WHAT IS DISCLOSED
BY THE APPLIED REFERENCE, HAS IGNORED CLAIM LIMITATIONS AND HAS
REJECTED THE CLAIMS BASED ON AN IMPROPER HINDSIGHT
RECONSTRUCTION OF THE CLAIMED INVENTION IN REJECTING CLAIMS 34-63

In rejecting claims, it is incumbent upon the Examiner to establish a factual basis

to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The Examiner is required to make the factual determinations (see e.g. Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 86 S. Ct. 684, 148 USPQ 459 (1966)), and to provide a reason for the rejection (see e.g. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such a reason must stem from some teaching or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA

1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Hindsight after the invention has been made is not the test. In re Carroll, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must disclose doing what applicant has done. In re Shaffer, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975).

As discussed above, it is respectfully submitted that the Examiner has rejected the claims without consideration of recited features, without reasonably considering what is taught and suggested by the applied reference, without properly construing the claims, and at best based on an improper hindsight reconstruction of the claimed invention.

4. CLAIMS 34-45 AND 56-63 ARE STATUTORY UNDER 35 U.S.C. §101

Each of the claims rejected under 35 U.S.C. §101 is directed to electronically presenting bills. As discussed in AT&T Corp. v. Excel Communications Inc., 172 F.3d 1352, 510 USPQ 2d 1447 (Fed. Cir. 1999) [quoted in Ex Parte Bowman], processes which are “electronic, chemical, or mechanical” are within the technological art or environment (See Ex Parte Bowman, 61 USPQ 2d 1669, 1671 (BdPatApp&Int 2001)).

Accordingly, to the extent that the two-prong test referenced by the Examiner is still valid, it is respectfully submitted that the present claims meet both prongs of the test. That is, the claims recite a disclosed invention which is well grounded in an area of the technological arts (i.e., the electrical arts) and, as acknowledged by the Examiner, clearly recite useful, concrete, and tangible results.

CONCLUSION

It is respectfully submitted that the Examiner (i) has failed to establish a prima facie case for the rejections, (ii) failed to reasonably construe that which is taught and suggested by the applied prior art, (iii) has failed to apply art which teaches or suggests the claimed invention, and (iv) applied art in a manner inconsistent with its teachings.

Thus, it is respectfully submitted that the rejection of the pending claims is improper.

In summary, Applicants respectfully submit that the applied references do not teach or suggest features recited in each of the independent claims, as well as features recited in the dependent claims, and the Examiner has failed to provide reasonable evidence to support a contrary conclusion. Accordingly, it is submitted that the art does not provide any teaching, or suggest, within its teachings, which would lead to the features or advantages of the instant invention, and the claims patentably define over the art. Additionally, applicants respectfully submit that the claims of the application are directed to statutory subject matter.

The rejection of the pending claims is in error, and reversal is clearly in order

and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read 'S.W. Chandler', followed by a long horizontal line extending to the right.

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APPENDIX OF CLAIMS UNDER APPEAL

34. A process for electronically presenting bills, comprising:

displaying, in a first portion of a single screen, a bill of a biller including at least one of a total amount due and a minimum amount due, and a payment due date; and

displaying, in a second portion of the single screen,
bill payment information including a payment date area for displaying a payment date, and a payment amount area for displaying a payment amount.

35. The process according to claim 34, wherein:

a payment date which pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner is automatically displayed initially in the payment date area as the payment date.

36. A process according to claim 35, wherein:

the particular manner of making payment is one of a first type payment mode and a second type payment mode;

if the particular manner of making payment is the first type payment mode, the automatically displayed payment date pre-dates the displayed payment due date by a first amount corresponding to the time period for making payment using the first

type payment mode; and

if the particular manner of making payment is the second type payment mode, the automatically displayed payment date pre-dates the displayed payment due date by a second amount, different than the first amount, corresponding to the time period for making payment using the second type payment mode.

37. A process according to claim 36, wherein:

the first type payment mode is payment by hard copy check; and

the second type payment mode is payment by electronic fund transfer.

38. A process according to claim 34, wherein:

the displayed bill payment information includes a periodic payment area for displaying a periodicity at which further payments of the displayed payment amount are to be made after the displayed payment date.

39. A process according to claim 34, wherein:

the displayed bill payment information includes a payment status indicator for indicating a status of payment of the displayed payment amount.

40. A process according to claim 39, wherein:

the displayed payment information is displayed in a format of a check and includes the payment date displayed as a date of check, the payment amount displayed as an amount of the check, and a cancelled check stamp as the indication

that the displayed payment amount has been paid.

41. A process according to claim 34, further comprising:

receiving a user command to change the displayed payment date to a modified payment date; and

automatically changing the displayed payment date to the modified payment date in the displayed bill payment information, based on the user change date command.

42. A process according to claim 34, wherein the displayed bill payment information includes a payee area for displaying a payee name, and further comprising:

receiving a user command identifying a biller; and

automatically displaying a name of the identified biller as the payee name in the payee area;

wherein the bill and the bill payment information are displayed in response to the identification of the biller.

43. A process according to claim 42, wherein:

displaying, on the single screen, a selectable biller list including a plurality of billers; and

the received user command identifies the biller by selecting one of the plurality of billers from the selectable biller list.

44. A process according to claim 34, further comprising:

displaying, in a third portion of the single screen, at least one of a first indicator corresponding to terms and conditions associated with the displayed bill, a second indicator corresponding to advertisements, and a third indicator corresponding to customer care.

45. A process according to claim 34, wherein the displayed bill payment information is displayed in a check format.

46. A system for electronically presenting bills authorizing payment, comprising:

a display configured to present (i) in a first portion of a single screen, a bill of a biller including at least one of a total amount due and a minimum amount due, and a payment due date, and (ii) in a second portion of the single screen, bill payment information including a payment date area for displaying a payment date, a payment amount area for displaying a payment amount, and a payment authorization indicator for authorizing payment of the displayed payment amount on the displayed payment date;

an input device for activating the payment authorization indicator; and

a processor for generating a message to authorize payment of the displayed payment amount on the displayed payment date based on the activation of the payment authorization indicator.

47. The system according to claim 46, wherein:

a payment date which pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner is automatically displayed initially in the payment date area as the payment date.

48. A system according to claim 47, wherein:

the particular manner of making payment is one of a first type payment mode and a second type payment mode;

if the particular manner of making payment is the first type payment mode, the automatically displayed payment date pre-dates the displayed payment due date by a first amount corresponding to the time period for making the payment using the first type payment mode; and

if the particular manner of making payment is the second type payment mode, the automatically displayed payment date pre-dates the displayed payment due date by a second amount, different than the first amount, corresponding to the time period for making the payment using the second type payment mode.

49. A system according to claim 48, wherein:

the first type payment mode is payment by hard copy check; and

the second type payment mode is payment by electronic fund transfer.

50. A system according to claim 46, wherein:

the displayed bill payment information includes a listing of selectable periods;

the input device is further configured to receive a user selection of one of the listed selectable periods;

the bill payment area includes a payment period area for displaying the selected period;

the processor is further configured to generate the message to authorize payment of the displayed payment amount on the displayed payment date and thereafter at the displayed selected period based on the activation of the payment authorization indicator.

51. A system according to claim 46, wherein:

the display is further configured to present (i) in a first portion of another single screen, another bill including at least one of another total amount due and another minimum amount due, and another payment due date, and (ii) in a second portion of the other single screen, bill payment information including another payment date area for displaying another payment date, another payment amount area for displaying another payment amount, and a payment status indicator for indicating a status of payment of the displayed payment amount.

52. A system according to claim 51, wherein:

the display is further configured to display the payment information in a format of a check; and

the displayed payment information includes the payment date displayed as a date of the check, the payment amount displayed as an amount of the check, and a

cancelled check stamp displayed as the payment made indicator.

53. A system according to claim 46, wherein:

the input device is further configured to receive a user command to change the displayed payment date to a modified payment date;

the processor is further configured to automatically generate an instruction to change the displayed payment date to the modified payment date, based on the user change date command; and

the display is further configured to change the displayed payment date to the modified payment date in the payment date area, based on the generated instruction.

54. A system according to claim 46, wherein:

the display is further configured to display the bill payment information with a payee area for displaying a payee name, and to display a plurality of biller identifiers on the single screen;

the input device is further configured to receive a user command identifying one of the displayed plurality of billers;

the processor is further configured to automatically generate an instruction to display a name of the identified biller as the payee name in the payee area in the displayed bill payment information, based on the user command; and

the display is further configured to display the name of the identified biller as the payee name in the payee area, based on the generated instruction.

55. A system according to claim 46, wherein the displayed bill payment information is displayed in a check format.

56. A single screen display for electronically presenting bills, comprising:
a bill of a biller including at least one of a total amount due and a minimum amount due, and a payment due date; and

bill payment information including a payment date area for displaying a payment date which automatically pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner, and a payment amount area for displaying a payment amount.

57. A display according to claim 56, wherein:

the bill payment information includes a periodic payment area for displaying a periodicity at which further payments of the displayed payment amount are to be made after the displayed payment date.

58. A display according to claim 56, wherein:

the bill payment information includes a payment made indicator for indicating that the displayed payment amount has been paid.

59. A display according to claim 58, wherein:

the bill payment information is displayed as a check with the payment date

displayed as a date of check, and the payment amount displayed as an amount of the check, and a status indicator displayed as the indication of a status of payment of the displayed payment amount.

60. A display according to claim 56, wherein the bill payment information includes a payee area for displaying a payee name.

61. A display according to claim 56, further comprising:
a selectable biller list including a plurality of billers.

62. A display according to claim 56, further comprising:
at least one of a first indicator corresponding to terms and conditions associated with the displayed bill, a second indicator corresponding to advertisements, and a third indicator corresponding to customer care.

63. A display according to claim 56, wherein the bill payment information is displayed in a check format.

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PATENT

APPENDIX OF PREVIOUSLY ENTERED AFFIDAVITS AND/OR DECLARATIONS

NONE

APPENDIX OF BPAI AND FEDERAL COURT DECISIONS IN RELATED
PROCEEDINGS

NONE